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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,679	09/27/2001	Trent M. Molter	PES-0040	2897

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EXAMINER
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WILLS, MONIQUE M

ART UNIT	PAPER NUMBER
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1745

MAIL DATE	DELIVERY MODE
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07/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/965,679	<b>Applicant(s)</b> MOLTER ET AL.	
	<b>Examiner</b> Monique M. Wills	<b>Art Unit</b> 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-14, 19, 20, 22, 23, 27-29 and 55-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14, 19, 20, 22, 23 and 27-29 is/are allowed.
- 6) ☒ Claim(s) 55-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

This Office Action is responsive to the Amendment filed April 25, 2007, Claims 11-14, 19-20, 22,23 & 27-29. However the following rejections are maintained:

- Claims 55-57, 60 & 63 under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. U.S. Patent 4,485,138.
- Claim 61 under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. U.S. Patent 4,485,138 as applied to claims 11,23 & 55, in view of Leonida et al. U.S. Patent 5,324,565.
- Claims 58 & 59 under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. U.S. Patent 4,485,138 as applied to claims 11,23 & 55, in view of Furuse et al. JP 402245579.
- Claims 62 under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. U.S. Patent 4,485,138 as applied to claim 55 above.

*Interference*

An interference of claims 55-63 has been requested. However, an interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference. In the instant case, claims 55-63 are not patentable.

*Allowable Subject Matter*

Claims 11-14 & 22 are allowable over the prior art of record, because the prior art is silent to a dimpled pressure pad comprising an elastomeric member threaded through the dimples.

Claims 23 and 27-29 are allowable over the prior art of record, because the prior art is silent to a corrugated pressure pad comprising an elastomeric member threaded through the raised portions in the corrugated member.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

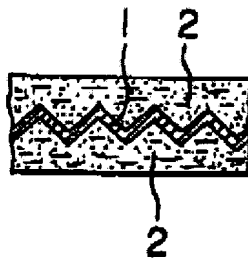
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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 55-57, 60 & 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. U.S. Patent 4,485,138.

In re claim 55, the material is a single sheet of electrically-conductive material with a top and bottom surface being bent up and down to include a plurality of alternating ribs and channels. See Figure 2. The elastomeric material (2) is mounted within the channels. The limitation with respect to the elastomeric material being compressed to lie flush with the ribs and exert substantially uniform pressure across each of the top and bottom surface, is considered an inherent property of the gasket taught by Yamamoto, because the reference teaches the exact same structure made of the same materials set for by Applicant.

**FIG. 2**

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With respect to claim 56, the ribs and channels are linear and parallel to one another. Specifically, the ribs on one surface, and the channels are on the opposite surface.

With respect to claim 57, the electrically-conductive material is steel (col. 4, lines 35-40).

As to claim 60, the elastomeric material is rubber (col. 3, lines 3-40).

With respect to claim 63, the electrically conductive material is rectangular in shape. See Figure. 2.

Therefore, Yamamoto anticipates the instant claims.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. U.S. Patent 4,485,138 as applied to claims 11,23 & 55, in view of Leonida et al. U.S. Patent 5,324,565.

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Yamamoto teaches a metal gasket coated with elastomeric rubber as described in the § 102 rejected recited hereinabove.

Yamamoto is silent to a silicon (claim 61) coated gaskets.

Leonida teaches the equivalence of rubber and silicon (col. 3, lines 35-45) as elastomeric gasket coatings.

Yamamoto and Leonida are analogous art, because they are from the same field of endeavor, namely, fabrication of elastomeric coated gaskets.

Therefore, although Yamamoto teaches rubber instead of silicon, Leonida shows that said silicon materials and rubber are equivalent materials known in the art. Therefore, because these materials were art recognized equivalents at the time the instant invention was made, one having ordinary skill in the art would have found it obvious to substitute one material for the other.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 58 & 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. U.S. Patent 4,485,138 as applied to claims 11,23 & 55, in view of Furuse et al. JP 402245579.

Yamamoto teaches a metal gasket coated with elastomeric rubber as described in the § 102 rejected recited hereinabove.

Yamamoto does not expressly disclose a gasket of copper (claim 58) or niobium (claim 59).

However, Furuse teaches that it is conventional to employ copper and niobium as gasket materials.

Yamamoto and Furuse are analogous art, because they are from the same field of endeavor, namely, fabricating gaskets.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was to employ copper and/or niobium in the gasket of Yamamoto, since the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).



*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. U.S. Patent 4,485,138 as applied to claim 55 above.

Yamamoto teaches an electrically-conductive compression pad as described hereinabove.

The reference is silent to the electrically-conductive material being circular in shape.

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to employ an electrically-conductive material in a circular shape to conform to tubular electrolysis cell stacks. The skilled artisan recognizes that the pad should have the same shape as the electrode so that the pressure is exerted uniformly across the sheet. Therefore, it is necessary for the material to have the same shape as the electrode material.

*Response to Arguments*

With respect to claims 55-63, Applicant contends that Yamamoto is neither anticipatory or obvious over the instant claims because the reference is silent to the elastomeric material lying flush with the ribs *when* the elastomeric material is compressed. Specifically, when the material of Yamamoto is compressed, the elastomeric material will always lie above every surface of the material. This argument is not persuasive. First, although the claims require that the elastomeric material lies flush with the ribs, this limitation does not preclude the elastomeric material from extending above the ribs. In other words, the term “ flush” does not appear to require a flat surface. *Additionally, “ when said” does not require the condition to occur. Stated differently, compression is not necessarily required by the claim language.* However, assuming arguendo that “ flush” requires a flat surface, the limitations in the claim are conditional. The claim language does not require compression of the conductive material, because the language is optional. In accordance with MPEP 2106, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Therefore, “ flush” does not limit the claim.

*Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

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If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Patrick Ryan, may be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**PATRICK JOSEPH RYAN**  
**SUPERVISOR, PATENT EXAMINER**

MW

7/6/07